

U.S. Application Serial No. 09/200,743

Recognizing this shortcoming, the Examiner further relies on Berge. But Berge is simply a laundry list of acids as of the 1960's. There is nothing in Berge that directs the worker of ordinary skill in the art to the use of the applicants' claimed sulfonate salts. The Examiner's argument is, nonetheless, that it would have been obvious to select one from among many. This position is improper.

The Examiner must identify a motivation or suggestion in the prior art itself directing the Examiner's proposed modification in order to establish a prima facie case of obviousness. The fact that the modification is possible does not render the combination obvious. Indeed, the combination to a combination lock is not obvious from inspection of the dial; despite the fact that the combination is certainly one of the many possibilities.

Here, the Examiner does not have any proper motivation to select the applicants' claimed sulfonate salts. Only through improper hindsight reconstruction can the Examiner pick from the universal, generic disclosure of "any of the available pharmaceutically acceptable acids" the applicants' specifically claimed sulfonate salts.

Furthermore, the impropriety of the Examiner's position is not helped by the citation of the Patent to Krage et al. (5,955,475). This disclosure is not prior to the present invention. The fact that after the filing of the present application, the use of a methyl sulfonate salt was suggested, does not evidence in any way the obviousness of the selection of such a salt at the time of the present invention. Therefore, the Examiner has failed to establish a prima facie case of obviousness.

Finally, the present application indicates that the claimed sulfonate salts provide superior results over the hydrochloride and other salts set forth in the prior art. These

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advantages include superior solubility. Nowhere are these advantages suggested by the cited prior art. Therefore, the invention as whole must be considered to be non-obvious.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 8, 15, 17, and 20-22 have been rejected under 35 U.S.C. 103 over Stemp, EP 190496 (Stemp), in view of Drejer et al, EP 266574 (Drejer), or Christensen. This rejection is respectfully traversed.

As pointed out above, the prior art does not properly suggest the formation of the sulfonate salts of formula I. None of Stemp, Drejer or Christensen specifically show the formation of the claimed sulfonate salts. While forming an acid addition salt from a free base and the like is generically known to chemists, the instant claims require the combining of specific base and acid. The cited prior art does not lead the worker of ordinary skill in the art to combining the applicants' base and acid. In the absence of such suggestion or motivation in the prior art, the presently claimed invention is novel and unobvious. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

In view of the above remarks, all claims define novel, patentable subject matter. Reconsideration of the rejections and allowance of the application are respectfully requested.

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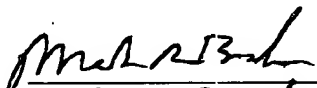
Should the Examiner have any questions regarding this matter, she is encouraged to contact Mark R. Buscher (Reg. No. 35,006) at telephone no. (202) 659-6938.

Respectfully submitted,


Mark R. Buscher (Reg. No. 35,006)

Dickinson Wright PLLC
1901 L Street, N.W.
Washington, D.C. 20036
(202) 457-0160

I certify that this Request for Reconsideration is being transmitted to the U.S. Patent & Trademark Office on March 7, 2000, by facsimile transmission.


Mark R. Buscher

March 7, 2000